(1)

88-308

Supreme Court, U.S.
FILED
AUG 10 1988
JOSEPH F. SPANIOL, JR.
CLERK

No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Respondents *

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
1603 Danbury Drive
Claremont, CA 91711
(714) 624-1801

Pro se petitioner

---

* see APPENDIX A for a complete list of all Respondents

QUESTIONS PRESENTED FOR REVIEW

1. Whether, absent the determination under 35 USC 302 *et seq.*, the re-examination of patents in the district court denies the patent owner a full trial and due process.

2. Whether the grant to the district court of discretion to determine whether the Patent Office procedure under 35 USC 302 *et seq.* should be utilized and to determine the taxing of costs against patent owners for errors made by the Patent Office in granting patents is inconsistent with due process under the 5th Amendment and the prohibition for imposing excessive fines under the 8th Amendment to the Constitution.

3. Whether the validity of the two patents in suit was decided in conflict with applicable decisions of this Court.

LIST OF PARTIES

See APPENDIX A for a list of parties.

TABLE OF CONTENTS

	Page
OPINION BELOW	1
JURISDICTION	2
CONSTITUTIONAL PROVISIONS INVOLVED	2
STATEMENT OF THE CASE	3
REASONS FOR GRANTING THE WRIT	6
1. Different Standards for Determining Validity of a Patent	6
2. Different Standards for Determining Costs of Reexamination of Patents	8
3. Improper Tests Invalidating Patents	11
CONCLUSION	18

TABLE OF AUTHORITIES

Cases	Page
Graham v. John Deere 86 S.Ct. 684 (1966), 148 USPQ 459	11,15,16, 17.19
In re Foster 343 F 2d 980, 145 USPQ 166 (CCPA 1965)	11
Package Devices, Inc. v. Sun Ray Drug Co., 432 F 2d 272, 167 USPQ 198 (3d Cir 1970) . . .	11
Pittway Corp. v. Black & Decker, Inc., 5USPQ2d 1052, 1057 (DC ND Ill 1987)	12
Stratoflex, Inc. v. Aeroquip Corp. 218 USPQ 871 (Fed Cir 1983). .	11

TABLE OF AUTHORITIES

Statutes	Pages
28 USC 1254(1)	2
28 USC 1338	5
35 USC 102(b) and 103	4,5,11
35 USC 282(2)	5,7
35 USC 302 et seq.	passim
Constitution	
5th Amendment	2,7,10,18
8th Amendment	2,10
Other Authorities	
Public Law 96-517	18
H.R. 96-1307, 96th Congress 2d Session (1980)	18
Chisum, Patents, Section 11.07(4)(c)	6
P. Rosenberg, Patent Law Fundamentals, 15.09(3) 2d ed 1986 . .	9

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit decided 9 June, 1988 attached as APPENDIX A.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its decision affirming the judgement of the United States District Court for the Southern District of California attached as APPENDIX B, invalidating the two patents in suit. By order filed 8 July, 1988 (App. A-64), the Court of Appeals for the Federal Circuit denied petitioner's Petition for Rehearing.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

CONSTITUTIONAL PROVISIONS INVOLVED

United States Constitution, 5th Amendment:

> No person shall be . . . deprived of . . . property, without due process of law . . .

United States Constitution, 8th Amendment:

> . . nor excessive fines imposed . .

STATEMENT OF THE CASE

Petitioner filed an action CV 85-0262 for infringement of Constitutional rights, Civil rights, Patent rights, Federal Unfair Competition, Antitrust, and California Unfair Competition. Non-patent claims were immediately dismissed for failure to state a claim upon which relief could be granted.

As to the remaining patent claim, petitioner recommended the Patent Office procedure for reexamination of patent validity and respondents opposed. The court appointed a special master recommended by respondents. Petitioner objected to the master's admitted lack of qualifications in any technology and also objected to the payment of the master's fees and informed the court that appointment of the special master would create financial hardship on him. The court assisted by the

admittedly unqualified master found the two patents invalid under 35 USC 102(b) and 103. Patent 3,950,635 ('635) was found invalid over the Stalcup patent and Allen & Westerfield (A&W) article and Patent 4,438,491 ('491) was found invalid over the Intel Exhibit 5. The court also ordered petitioner to pay the costs of litigation of the validity of the two patents in the amount of $123,832 (App. B-65). The Stalcup and A&W references were generated by the Patent Office and Government R&D respectively. The Intel reference was generated by respondent Intel.

In district court proceedings, for patents and publications, the reexamination of patents under 35 USC 102(b) and 103 is authorized under 35 USC 282(2). In Patent Office proceedings, the reexamination of patents is authorized under 35 USC 302 et seq. The cost of reexamination of a patent in the Patent Office is $1,770.

The district court's jurisdiction for patent claims was invoked under 28 USC 1338.

REASONS FOR GRANTING THE WRIT

1. Different Standards for Determining Validity of a Patent

There are two different standards for determining the validity of a patent. In the Patent Office under 35 USC 302 et seq. the reexamination requires a determination of issue by the Commissioner of Patents (35 USC 303) and reexamination (35 USC 304,305), if an issue is found to exist. Under 35 USC 303, the Patent Office will consider whether references are in the pertinent or analogous art, whether they were not considered in connection with the initial examination and whether they are more pertinent than the prior art that was considered. For authorities and description of the Patent Office Reexamination Procedure see Chisum, Patents, Section 11.07(4)(c).

In the district court under 35 USC 282(2) the reexamination does not require a determination of issue (as would be required in the Patent Office under 35 USC 303).

> "There is no legal authority for the view that the court must first determine that the prior art in the evaluation of obviousness is more pertinent than the prior art considered by the PTO"
>
> App. A-57.

Absent the determination of issue by the Commissioner of Patents (35 USC 303) and absent the Patent Office reexamination, if any, the petitioner was denied a full trial on the materiality of the (Stalcup, A&W, and Intel) references used by the district court to invalidate patents in violation of petitioner's 5th Amendment due process.

2. Different Standards for Determining Costs of Reexamination of Patents

There was no wrongdoing by the petitioner in obtaining the two patents in suit to justify the taxing of costs against him. The two patents were found invalid over references allegedly not considered by the Patent Office in granting patents. *

The court's refusal to utilize the Patent Office procedure under 35 USC 302 et seq. amounts to an abuse of discretion.

---

* Absent the determination of the issue by the Commissioner of Patents (35 USC 303) it is not known whether the Stalcup, A&W, and Intel references relied upon by respondents to invalidate patents were considered or that these are more pertinent than the art that was considered in granting patents.

P. Rosenberg, Patent Law Fundamentals, 15.09(3) at 15-167 2d ed 1986 ("In cases which have not progressed beyond . . . initial litigation stage, the reexamination procedure should be utilized)(underline added).

The court abused its discretion in appointing a special master who admits the lack of qualification in any technology.

Thus, the costs taxed against the petitioner were completely unnecessary in view of the low cost proceedure for reexamination in the Patent Office under 35 USC 302 et seq.

The grant to the district court of a wholly standardless discretion to determine whether the Patent Office procedure under

35 USC 302 et seq. should be utilized and further to determine the taxing of costs against petitioner for errors made by the Patent Office in granting patents is a violation of petitioner's 5th Amendment due process and amounts to imposing of excessive fines on the petitioner without good cause in violation of the 8th Amendment to the Constitution.

3. Improper Tests Invalidating Patents

In Graham v. John Deere, 148 USPQ 459 (1966), this Court held that in applying 35 USC 103 the courts should make "several basic factual inquiries". The inquiries are "the scope and content of the prior art", "differences between the prior art and claims at issue", and "the level of ordinary skill in the pertinent art". When secondary evidence appears in the record it should also be considered. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed Cir 1983). The same obviousness standard applies to 35 USC 102(b). In re Foster, 343 F 2d 980, 145 USPQ 166 (CCPA 1965); Package Devices, Inc. v. Sun Ray Drug Co., 432 F 2d 272, 167 USPQ 198 (3d Cir 1970).

The sole issue is whether the "several basic factual inquiries" were made in this case. That they were not is evidenced by the record.

The district court's judgements invalidating the two patents were made by a non-technical judge assisted by a special master who admits that he has "no expert qualifications in this or any other technology" and who qualifies only "as a patent lawyer experienced in communicating with such experts" and further admits "I would not be qualified to testify as a technological expert". See Exhibit 16 in appellant's Exhibits in Appeal 88-1101. Pittway Corp. v. Black & Decker, Inc., 5 USPQ2d 1052, 1057 (DC ND Ill 1987)(expert who lacks expertise with rechargeable devices and who admits that he is not a person of ordinary skill in the art failed to show by clear and convincing evidence that re-

chargeable flashlight invention was obvious). The admittedly unqualified master made two technical reports to the court and twice testified under oath on the technical merits of the two patents. The two reports (one for each patent) were submitted privately to the court (see Exh 37 in appellant's Exhibits in Appeal 88-1101) in violation of FRCP 53(e)(1). Two hearings were held (one for each patent) during which the master testified under oath on the technical merits of the two patents. See transcripts for hearings on 30 March, 1987 and 4 May, 1987. The court's decision to invalidate the two patents was announced from the bench at the hearing on 4 May, 1987 at which time the court ordered respondents to submit their proposed findings of fact, conclusions of law and judgement. See the

district court's opinion attached as APPENDIX B. Essentially then, petitioner's patents were tried by a patent lawyer who admits having no technical qualifications in the art in violation of petitioner's demand for a jury trial.

As stated previously, notably absent in the district court's reexamination of the two patents was the Patent Office expert judgement under 35 USC 303 about the materiality of the Stalcup, A&W, and Intel references. In making the "several basic factual inquiries" the court relied solely on the references submitted by respondents as being the prior art for purposes of obviousness determinations. In the case of the '491 patent the court relied on the publications submitted by respondent Intel. App.

A-43 . In the case of the '635 patent the scope and content of the prior art and the differences between the claims at issue and the prior art were ascertained using the submitted documents. App. A -48. Since material cited by the Patent Office was not considered, it is clear that neither the District Court or the Court of Appeals applied the correct test under Graham, supra.

This Court has already "observed a notorious difference between the standards applied by the Patent Office and by the courts". Graham, supra 694. The same observation led Congress to enact 35 USC 302 et seq. as the appropriate standard for the reexamination of patents. In both Graham, supra and 35 USC 303 the prior art consists of material cited by the Patent

Office as well as new material being relied upon by patent challengers. Graham, supra 696, 700.

Equally absent in the district court's reexamination of the two patents was the material for secondary considerations offered by petitioner. See (4)D and (5)D in Appellant's Reply in appeal 88-1101.

But even where the differences between the claims at issue were ascertained using the references submitted by respondents, the results are clearly erroneous. For example, the decision App. A-41 states that the '491 patent is invalid because the specification does not suggest that a computer program is part of the invention. However, such a program is suggested at Col 7 lines 4-8 of the specification and is provided in

the Rabiner and Gold reference given (Appellant's Exhibit 27 in appeal 88-1101). Likewise, the decision App. A-54 states that the '635 patent is invalid because the claims do not involve semiconductor RAMs and $\log_2 n$ lines disclosed in the specification. However, the claims are means claims which "shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof". 35 USC 112 last paragraph. See App. A-56.

From the foregoing it is clear that, the "several basic factual inquiries" required by Graham, supra and intended by Congress in enacting 35 USC 303 were not made in this case with prior art cited by the Patent Office and where made with art relied on by respondents were clearly erroneous.

CONCLUSION

Absent the determination of issue by the Commissioner of Patents (35 USC 303) and absent the Patent Office reexamination, if any, petitioner was denied a full trial on the materiality of the Stalcup, A&W, and Intel references used to invalidate patents in violation of petitioner's right for due process under the 5th Amendment.

And, without any wrongdoing on his part in obtaining patents, the petitioner has and is being subjected to the types of abuses that Congress sought to cure by enacting 35 USC 302 et seq.

> "The reexamination of issued patents should be conducted with a fraction of the time and cost of formal legal proceedings . . .". See House Report on the Bill which became Public Law 96-517, H.R. 96-1307, 96th Congress 2d Session (1980) at 3-4.

The message for the reexamination of patents under 35 USC 302 et seq. has not reached the federal courts and, as demonstrated in the present case, the abuse of persons like appellant continues with impunity. As expressed by 35 USC 302 et seq. patent owners are entitled to the determination of issue by the Commissioner of Patents (35 USC 303) and reexamination (35 USC 304,305), if any, the absence of which in formal court proceedings deprive the patent owner a full trial and expose him to unnecessary costs.

The tests required by Graham, supra and intended by Congress in enacting 35 USC 303 were not made in this case.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit attached as APPENDIX A.

Respectfully submitted

Date:
17 August, 1988

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT was served on all parties on 17 August 1988 by mailing first class a true and correct copy thereof to them addressed as follows:

cc: Counsel for Advanced Micro-Devices, Inc. and Intel Corporation

Edwin Taylor
Blakely, Sokoloff, Taylor & Zafman
12400 Wilshire Blvd., 7th Fl.
West Los Angeles, CA 90025

Counsel for Gould, Inc. and American Microsystems, Inc.

Joseph Golant
Romney, Golant, Marten & Ashen
10920 Wilshire Blvd.
Suite 1000
Los Angeles, CA 90024

Counsel for Analog Devices, Inc. and NEC Electronics, Inc.

Robert Schroeder
Pretty, Schroeder, Brueggeman & Clark
444 South Flower Street, Suite 2000
Los Angeles, CA 90071

Counsel for Fujitsu Microelectronics, Inc.

Richard Fybel
Morrison & Foerster
333 South Grand Avenue
38th Fl.
Los Angeles, CA 90071

Counsel for Digital Switch, Inc. and
Granger Associates, Inc.

Howard Brody
Grossman, Graven, Perry & Block
523 West Sixth Street, Suite 1130
Los Angeles, CA 90014-1109

Counsel for Hitachi America, Ltd.

Martin Horn
Spensley, Horn, Jubas & Lubitz
188 Century Park East, 5th Fl.
Los Angeles, CA 90067

Counsel for Paradyne Corp.

Kristin Cano
Curtis & Vaccaro
Manufacturers Bank Bldg.
One Newport Place, Suite 700
Newport Beach, CA 92660

Counsel for Texas Instruments, Inc.

Paul Malingagio
Sheppard, Mullin, Richter & Hampton
333 South Hope Street, 48th Fl.
Los Angeles, CA 90071

Counsel for Rockwell International Corp.
and TRW, Inc.

Allen Katz
Munger, Tolles & Rickershauser
612 South Flower Street, 5th Fl.
Los Angeles, CA 90017

Solicitor General
Department of Justice
Washington, D.C. 20530

Date: 17 August 1988

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner